



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,158	04/23/2001	Hirokazu Kawamoto	35.G2785	1598

5514 7590 06/27/2005

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

RAHIMI, IRAJ A

ART UNIT	PAPER NUMBER
----------	--------------

2622

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/839,158

Applicant(s)

KAWAMOTO ET AL.

Examiner

(Iraj) Alan Rahimi

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2001.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-66 is/are pending in the application.
4a) Of the above claim(s) 1-42 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 43-66 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☒ Claim(s) 1-42 are subject to restriction and/or election requirement.


Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 23 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


TWYLER LAMB
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-6, drawn to print processing and printing in original layout and modified layout , classified in class 358, subclass 1.18.
 - II. Claims 7-42, drawn to print processing based on different print modes, classified in class 358, subclasses 1.13 and 1.16.
 - III. Claims 43-66, drawn to an image processing apparatus capable of setting plurality of output formats from one piece of data, classified in class 358, subclasses 1.1, 1.13 and 1.18.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I, II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the Group II does not need the deleting control means of the image data. The subcombination has separate utility such as memory control.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Art Unit: 2622

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II and III, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Mr. Mark Williamson on June 15, 2005 a provisional election was made with traverse to prosecute the invention of Group III, claims 43-66. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-42 were withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Response to Amendment

6. In papers filed on April 23, 2001, applicant provided a supplemental amendment to correct the typographical errors in claims 19 and 50.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 55-66 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 55-66 drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

Art Unit: 2622

“Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer.”

“Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure’s functionality to be realized.”

Claims 55-66, while defining a storage medium and a program do not define a “computer-readable medium” and is thus non-statutory for that reasons. A storage medium and program can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on “computer-readable medium” in order to make the claim statutory.

“In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory.” - MPEP 2106.IV.B.1(a)

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

Art Unit: 2622

do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. *Claims 43-66 are rejected under 35 U.S.C. 102(e) as being anticipated by Miyamoto et al. (US patent 6,456,391).*

Regarding claim 1, Miyamoto discloses an information processing apparatus (printer 22) for producing print data to be printed by a printing apparatus, comprising:

setting means capable of setting a plurality of output formats for one piece of data to be printed (fig. 3, printing buttons 54 and 59);

producing means for producing, from the data to be printed, a plurality of print jobs including print data corresponding to the plurality of output formats set by said setting means (Thumbnail image and full size, column 6, lines 20-30) ; and

execution control means for controlling execution such that printing is executed in accordance with the plurality of print jobs produced by said producing means (column 4, lines 58-67 and column 6, lines 20-30).

Regarding claim 44, Miyamoto discloses an information processing apparatus according to Claim 43, wherein said setting means is capable of setting a combination of predetermined output formats (Thumbnail and full size prints).

Regarding claim 45, Miyamoto discloses an information processing apparatus according to Claim 44, wherein said combination of predetermined output formats includes a first output format in which one page is output on one sheet and a second output format in which a plurality of pages are output on one sheet. Thumbnail print has a plurality of images on one sheet where full size picture is printed on a separate sheet.

Regarding claim 46, Miyamoto discloses an information processing apparatus according to Claim 43, wherein said setting means is capable of setting an arbitrary combination of output formats. Full size and thumbnail print sizes.

Regarding claim 47, Miyamoto discloses an information processing apparatus according to Claim 43, wherein said producing means comprises:

storing means DRAM 32 for storing, in a predetermined data format, said data to be printed and output form information indicating the plurality of output format set by said setting means;

converting means for converting the data to be printed stored in the predetermined data format in said storing means into print data so as to obtain printing outputs in the output formats indicated by the output form information stored in the said storing means (column 4, lines 30-40); and

Art Unit: 2622

print job producing means for producing a plurality of print jobs by producing, using said converting means, print data corresponding to the respective output formats set by said setting means (column 4, lines 58-67).

Regarding claim 48, Miyamoto discloses an information processing apparatus according to Claim 43, wherein said execution control means transmits the print job produced by said producing means to the printing apparatus.

Other Prior Art Cited

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Murray (US patent application 2002/0109854) discloses method and apparatus for printing and or displaying digital images.

Contact Information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Iraj) Alan Rahimi whose telephone number is 571-272-7411. The examiner can normally be reached on Mon.-Fri. 8:00-4:30.

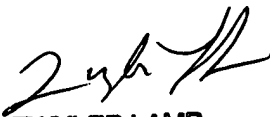
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR

Alan Rahimi
June 20, 2005


TWYLER LAMB
PRIMARY EXAMINER